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In re Application of: BLACKWELL, R. J. et. al.
Application No. **10/523,380**
Filed: February 01, 2005
Docket No. GB 030054
Title: NETWORK ESTABLISHMENT AND MANAGEMENT PROTOCOL

DECISION ON PETITION
UNDER 37 C.F.R. § 1.181

This is a decision on the petition filed November 28, 2008 under 37 CFR § 1.181 to invoke Supervisory Authority of the Commissioner for the requirement that Applicant provide either a terminal disclaimer or a traversal of a rejection for non-statutory double patenting, and specifically seek relief that their ***offer*** to file a terminal disclaimer when all other rejection and objections are negated ***be considered fully responsive*** to the current double patenting rejection.

The Applicant's counsel filed a petition to the Director under 37 CFR § 1.181 to seek relief from actions of the Examiner in relation to Notice of Non-responsive reply/amendment under 37 CFR 1.111 mailed December 08, 2008. The Amendment and Response document filed on October 27, 2008 was considered non-responsive by Examiner as failing to meet the requirement of 37 CFR 1.111 because it failed to respond to the double patenting rejection set forth in non-final office action mailed June 25, 2008.

Accordingly, the petition is **GRANTED.**

RULES AND REGULATIONS

MPEP §804.02 Avoiding a Double Patenting Rejection

A rejection based on a nonstatutory type of double patenting **can** be avoided by filing a terminal disclaimer in the application or proceeding in which the rejection is made. In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); In re Knohl, 386 F.2d 476, 155 USPQ 586 (CCPA 1967); and In re Griswold, 365 F.2d 834, 150 USPQ 804 (CCPA 1966). The use of a terminal disclaimer in overcoming a nonstatutory double patenting rejection is in the public interest because it encourages the disclosure of additional developments, the earlier filing of applications, and the earlier expiration of patents whereby the inventions covered become freely available to the public. In re Jentoft, 392 F.2d 633, 157 USPQ 363 (CCPA 1968); In re Eckel, 393 F.2d 848, 157 USPQ 415 (CCPA 1968); and In re Braithwaite, 379 F.2d 594, 154 USPQ 29 (CCPA 1967).

The filing of a terminal disclaimer to obviate a rejection based on nonstatutory double

patenting is not an admission of the propriety of the rejection. Quad Environmental Technologies Corp. v. Union Sanitary District, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991). The court indicated that the "filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection."

A terminal disclaimer filed to obviate a double patenting rejection is effective only with respect to the application identified in the disclaimer, unless by its terms it extends to continuing applications.

MPEP §804.02 (VI) TERMINAL DISCLAIMERS REQUIRED TO OVERCOME NONSTATUTORY DOUBLE PATENTING REJECTIONS IN APPLICATIONS FILED ON OR AFTER JUNE 8, 1995

There are at least two reasons for insisting upon a terminal disclaimer to overcome a nonstatutory double patenting rejection in a continuing application subject to a 20-year term under 35 U.S.C. 154(a) (2). First, 35 U.S.C. 154(b) includes provisions for patent term extension based upon prosecution delays during the application process. Thus, 35 U.S.C. 154 does not ensure that any patent issuing on a continuing utility or plant application filed on or after June 8, 1995 will necessarily expire 20 years from the earliest filing date for which a benefit is claimed under 35 U.S.C. 120, 121, or 365(c). Second, 37 CFR 1.321(c)(3) requires that a terminal disclaimer filed to obviate a nonstatutory double patenting rejection based on commonly owned conflicting claims include a provision that any patent granted on that application be enforceable only for and during the period that the patent is commonly owned with the application or patent which formed the basis for the rejection.

37 CFR 1.321(d) sets forth the requirements for a terminal disclaimer where the claimed invention resulted from activities undertaken within the scope of a joint research agreement. These requirements serve to avoid the potential for harassment of an accused infringer by multiple parties with patents covering the same patentable invention. See, e.g., In re Van Ornum, 686 F.2d 937, 944-48, 214 USPQ 761, 767-70 (CCPA 1982).

Not insisting upon a terminal disclaimer to overcome a nonstatutory double patenting rejection in an application subject to a 20-year term under 35 U.S.C. 154(a)(2) would result in the potential for the problem that 37 CFR 1.321(c)(3) was promulgated to avoid. Accordingly, a terminal disclaimer under 37 CFR 1.321 is required in an application to overcome a nonstatutory double patenting rejection, even if the application was filed on or after June 8, 1995 and claims the benefit under 35 U.S.C. 120, 121, or 365(c) of the filing date of the patent or application which forms the basis for the rejection.

MPEP §1501 (II) NONSTATUTORY DOUBLE PATENTING REJECTIONS:

A nonstatutory double patenting rejection of the obviousness-type applies to claims directed to the same inventive concept with different appearances or differing scope which are patentably indistinct from each other. Nonstatutory categories of double patenting rejections which are not the "same invention" type may be overcome by the submission of a terminal disclaimer. The purpose of a terminal disclaimer is to obviate a double patenting rejection by removing potential harm to the public by issuing a second patent.

OPINION

A review of the file, particularly, the requirements under § 1.111 Reply by applicant or patent owner to a non-final Office action. Applicant's response "replies" to every ground of objection and rejection in the prior Office action, as required.

The nonstatutory double patenting rejection based on judicially created doctrine grounded in public policy filed on non-final office action mailed 06/25/08, has **not** been overcome by the submission of a terminal disclaimer, as is hereby **sustained.**

Amendment and Response document filed on October 27, 2008 is considered responsive as meeting the requirement of 37 CFR § 1.111, thus the notice of non-responsive mailed December 08, 2008 is hereby **withdrawn.**

The terminal disclaimer will obviate the double patenting rejection upon filing by removing potential harm to the public by issuing a second patent.

Accordingly, the petition is **GRANTED.**

The application will be forwarded to the Examiner to withdraw Notice of non-responsive reply mailed December 08, 2008.

Any inquiry regarding this decision should be directed the undersigned whose telephone number is (571) 272-3902. If attempts to reach the undersigned by telephone are unsuccessful, Kim Huynh, Quality Assurance Specialist, can be reached at (571) 272-4147.

/bp/

Beatriz Prieto

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10/523,380	02/01/2005	Robin J. Blackwell	GB 030054	3721

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EXAMINER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.